

REMARKS

Claims 1 and 32–47 are pending in the present application.

Claims 1 and 38 were amended.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 112, First Paragraph (Written Description)

Claims 1 and 32–45 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

Independent claims 1 and 38 have been amended to eliminate the subject matter asserted in the Office Action to not be supported by the application as filed.

Therefore, the rejection of claims 1 and 32–45 under 35 U.S.C. § 112, first paragraph has been overcome.

35 U.S.C. § 103 (Obviousness)

Claims 1, 32, 35, 38–39 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,169,792 to *Katoh et al.* Claims 33 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Katoh et al* in view of U.S. Patent No. 4,110,899 to *Nagasawa et al.* Claims 34 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Katoh et al* in view of *Nagasawa et al* and further in view of JP 63-271956 (*Hosaka*). Claims 36–37 and 43–45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Katoh et al* in view of *Nagasawa et al* and further in view of Wolf et al, *Silicon Processing For the VLSI Era, Vol. 2*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-128 (8th ed. rev. 2 May 2004). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

Independent claims 1 and 38 teach forming channel stop implants in a first conductivity-type region masked by an overlying patterned photoresist used to pattern an active stack to expose isolation areas in the first conductivity-type region, then forming channel stop implants in a second conductivity-type region masked by another overlying patterned photoresist used to pattern the active stack to expose isolation areas in the second conductivity-type region. The second patterned photoresist is formed directly on the exposed surface of the substrate in the isolation areas in the first conductivity-type region (i.e., no isolation oxide is grown between implants). Such a feature is not found in the cited references. *Kotah et al* teaches alternative processes for forming opposite conductivity-type wells (i.e., a p-well in an n-type substrate or a n-well in a p-type substrate),

followed by channel stop implants using a single masking step, using counterdoping. No motivation exists for combining selected patterning steps from the two alternative processes as proposed in the Office Action, nor does the reference provide any reasonable expectation of success in such a selective combination.

Therefore, the rejection of claims 1 and 32–45 under 35 U.S.C. § 103 has been overcome.


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: 2-9-05


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